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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,566	03/06/2001	Robert Olan Keith JR.	ABREAU-00107	4072

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EXAMINER

NGUYEN, CAM LINH T

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/800,566

Applicant(s)

KEITH, ROBERT OLAN

Examiner

Cam-Linh T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-5.                      6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1 – 32 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 - 38 of copending Application No. 09/801,140. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims Comparison Table

	'140	'566
Claims	1-2, 4- 5, 14-15, 24-25, 34-35	1-2, 9-10, 17- 18, 25-26,31-32
	3, 13, 23, 33	8, 16, 24, 30,
	6, 16, 26, 36	3, 11, 19, 27,
	7, 17, 27, 37	4, 12, 20, 28,
	8, 18, 28,	5, 13, 21,
	9, 19, 30, 38	6, 14, 23, 29,
	10, 20, 29	7, 15, 22,

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3. ~~The nonstatutory double patenting rejection is based on a judicially created~~ doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 – 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 42 of copending Application No. 09/799,032.

#### Claims Comparison Table

	"566	'032
Claims	1, 9	1,
	2, 10,	4,
	3, 11, 19,	3
	4, 12, 20,	6
	5, 13,	7
	6, 14,	8,
	7, 15,	9,
	8, 16	2,
	17,	23,

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18,	26,
21,	29,
22,	30,
23,	31,
24,	24,
25,	34,
26,	37,
27,	36,
28,	39,
29,	40,
30	35
31	1, 4
32	1, 2

Certain limitations including, setting up a notify signal to notify user when new data is entered, found in '032 are not found in '566. However, they are not patentably distinct from each other because:

- In the instance application, Applicant claims a searchable database that is formatted into a directory tree structure comprising nodes, branches, links, and how to access to the information located in there.
- In the copending application, Applicant also claims a searchable database that is formatted into a directory tree structure comprising nodes, branches, links, and

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how to access to the information located in there. Further, Applicant applies a notification system to the invention to notify user when new data is entered.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been prima facie obvious to one with ordinary skill in the art at the time the invention was made to broaden the invention because this provides a wider application of the invention with no additional cost in development.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Specification***

5. The disclosure is objected to because of the following informalities: Applicant is requested to submit the status of all related application that submitted in the specification.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, 8 – 9, 12, 16 – 17, 20, 24 – 25, 28 - 32 are rejected under 35

U.S.C. 102(e) as being anticipated by Snow et al (U.S. 6,098,066).

♦ As per claim 1, 9, 17, 25, 31 – 32,

Snow teaches a method of accessing information in a searchable database comprising:

- "The searchable database is formatted in a directory tree structure" See Fig. 1, col. 2 line 62 – 67.
- "The directory tree structure includes nodes ... branches" See Fig. 1, element 12.
- "Branches comprising links between the nodes" See col. 3 line 36 – 38.

The database of Snow is formatted in a tree structure (col. 2, line 62 – 64), comprising nodes, and "related item of data" is corresponding to the data definition 28 in Fig. 1 (col. 3 line 3 – 11).

- "Categorizing each item of data by a navigation path through the directory tree structure and by one or more parameters" see col. 6, line 35 – 44, Snow. The "parameters" is corresponding to the "first group of data contains descriptive terms defining the corresponding leaf category", which are specific to the node.
- Users access the directory by a query (See Fig. 7 element 102, Snow), using an application-programming interface (See Fig. 2).

♦ As per claim 4, 12, 20, 28, Snow teaches:

- "The searchable database is distributed into more than one physical location" See Fig. 9, col. 9 line 6 – 16, Snow.

♦ As per claim 8, 16, 24, 30, Snow teaches:

- "Utilizing a selective one or more.... parametric search" See Fig. 2, element 30 of Snow, where "terms command" is corresponding to "keyword search".

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 – 3, 5 – 7, 10 – 11, 13 – 15, 18 – 19, 21 – 23, 26 – 27, 29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Snow et al (U.S. 6,098,066) as applied to claims 1, 4, 8 – 9, 12, 16 – 17, 20, 24 – 25, 28 – 30 above, and further in view of Drucker et al (U.S 6,292,796).

♦ As per claim 2, 10, 18, 26,

Snow teaches a method for access information in a specific node as set forth above, but does not clearly teach how the navigation path is saved as the query string.

However, Drucker, on the other hand, discloses a method for searching documents by specify the navigation path, such as selecting subjects, keyword search, etc. as illustrated in Fig. 1 (col. 2 line 31 – 48, Drucker). The access mechanism includes user setup which allows user specify search preferences (col. 6 line 63 – col. 7 line 6, Drucker). Those preferences are saved for later modification (See Fig. 10 – 11, Drucker).

By saving the query or search preferences, Drucker teaches, “the navigation path is saved as query string”. It would have been obvious to one with ordinary skill in the art at the time the invention was made to apply Drucker’s system of saving user preferences into the system of Snow, because the system of Drucker provides a great



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benefit in saving time for users (col. 1 line 56 – 58, Drucker). The combination of Drucker and Snow produces an easy search engine for users, where the user does not have to be familiar with the system and does not have to have a lot of time for a search query.

♦ As per claim 3, 11, 19, 27, the combination of Snow and Drucker discloses:

- "Links to other nodes within the directory tree structure, links to web sites external to the electronic system". Snow discloses a link ID is used to link to other node (See col. 3 line 36 – 38, Snow), and the system of Snow used the Internet to connect with other database (See col. 1 line 38 – 47, Drucker).

♦ As per claim 5 - 7, 13 – 15, 21 – 23, 29, the combination of Snow and Drucker discloses:

Because the combination system includes Internet access, therefore, the notification must have server to perform this functions.

- "Establishing an Internet connection with the server" See Fig. 12, col.15 line 38 – 52, Drucker.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Danish et al (U.S. 6,327,588) discloses a method and system for executing a guided parametric search.
- Beall et al (U.S. 6,484,165) discloses a method and system for database manipulation.

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- Paul P. Vagnozzi (U.S. 6,499,033) discloses a database method and apparatus using hierarchical vector index structure.
- Ryan et al (U.S. 6,421,675) discloses a search engine.
- Snow et al (U.S. 6,185,550) discloses a method and apparatus for classifying documents within a class hierarchy creating term vector, term file and relevance ranking.
- Powers et al (U.S. 5,442,784) discloses a data management system for building a database with multi-dimensional search tree nodes.
- Yoshida et al (U.S. 6,212,518) discloses a system and method for retrieval of data from related databases based upon database association model.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cam-Linh T. Nguyen whose telephone number is 703-305- 1951. The examiner can normally be reached on Monday - Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308- 1436. The fax phone number for the organization where this application or proceeding is assigned is 703- 746- 7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703- 305- 3900.

Cam-Linh Nguyen  
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